

Remarks

Applicant has amended claim 19, 24 and 25; and canceled claims 23 and 47. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. Entry of the amendment and favorable consideration thereof is earnestly requested.

Rejections under 35 U.S.C. §112, First Paragraph

As amended, claim 24 recites, "The medical instrument of claim 19 in which said touch screen is easier to deflect in one direction than in the other direction." Claim 25 recites, "The medical instrument of claim 25 in which said touch screen is more difficult to deflect in the opening direction than in the closing direction."

The Examiner has rejected claims 24 and 25 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The examiner has submitted,

said touch screen is easier to deflect in on direction (opening) than in the other direction (closing). According to the specification, the touch screen is attached by a 'hinge 142' that is equipped with 'one or more tapping mechanisms'. Conventional hinges are equally easy to deflect in either direction. The specified 'hinge 142' appears to be a conventional hinge. The only unconventional feature is a 'tapping mechanism'. It is not entirely clear what a tapping mechanism is, but there is no suggestion that it makes the 'hinge 142' more deflectable in one direction than in another."

(Official Action 9/20/10, p. 3). The enablement requirement of 35 U.S.C. § 112 is concerned with whether the specification adequately describes how to make and use the invention. The analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims so as to enable one

skilled in the pertinent art to make and use the claimed invention. See MPEP § 2164.01.

As a preliminary matter, Applicant respectfully notes that the enablement requirement applies to those skilled in the art, not to an average person reading the patent. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 U.S.P.Q. 303, 315 (Fed. Cir. 1983) (“Patents, however, are written to enable those skilled in the art to practice the invention, not the public.”). Therefore, in order for a patent to suffer from lack of enablement, it must really be the case that a person who is actually skilled in the relevant art could truly not practice the claimed invention without conducting undue experimentation.

Starting from the perspective of those skilled in the art, a lack of enablement occurs when the disclosure leaves such skilled persons in a position where they still must perform extensive experimentation in order to practice the invention—in other words, they are required to engage, not merely in “some” experimentation, but in “undue” experimentation. *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988) (“Enablement is not precluded by the necessity for some experimentation... the key word is ‘undue,’ not ‘experimentation.’”); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986) (enablement “is not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly extensive.”).

Therefore, because “[t]he question is whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention... the specification need not disclose what is well known in the art.” *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). See also *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known

in the art without undue experimentation.”). In other words, the specification need not lay out every step necessary to practice the invention, but rather, must point those skilled in the art in the right direction so that they can, using the existing knowledge in the art, practice the invention. *In re Wands*, 858 F.2d at 737 (“The determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art... The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed.”). Therefore, “[a] patent need not teach, and preferably omits, what is well known in the art.” *Hybritech*, 802 F.2d at 1384.

Here, Applicants have disclosed a novel and nonobvious touch screen that presents greater resistant to opening than to closing as it is undesirable to have the touch screen deflect when a user is touching the screen to, for example, enter commands. The examiner has made factual conclusions with absolutely no evidentiary support, including, for example, that “Conventional hinges are equally easy to deflect in either direction” and that the “specified ‘hinge 142’ appears to be a conventional hinge.” What is a “conventional” hinge that the examiner is referring to? What evidence is there to support that “Conventional hinges are equally easy to deflect in either direction”? Additionally, the examiner’s comments that “there is no suggestion that it makes the ‘hinge 142’ more deflectable in one direction than in another” is undercut by the specification that states “To prevent changing angle of the platform 144 or accidental closure, one or more tapping mechanisms are disposed with hinge 142, that make it resistant to unintentional movement.” (§59). Clearly “hinge 142” is provided such that it is “resistant to unintentional movement”, however, it appears the examiner is suggesting that the mechanism that provides resistance to unintentional movement must be explained in detail. Applicant submits that variable friction hinges (exhibit more resistance in one direction than another), are notoriously well known need not be set forth in the specification in order for this disclosure to be enabling.

Applicant notes that those that are skilled in the art would not truly need to engage in undue experimentation in order to practice the claimed invention. Applicant again notes that the omission of explanations of known elements not only does not present an enablement issue, but it is, in fact, preferred.

Examiner's Comments Regarding Withdrawn Rejections

Initially, Applicant objects to the examiner's comments relating to the combination of Beutter in view of Winkler. The BPAI overturned the rejection of claim 19 on the combination of Beutter in view of Winkler, therefore comments presented relating to the combination of these references is inappropriate. The comments listed in the Official Action of 9/20/10 have necessitated a response by Applicant. It was submitted that at "the time of the invention, it would have been obvious to a person of ordinary skill in the art to tilt the device ever so slightly such that the touch screen extends out from the vertically extending boundaries of the footprint of the housing. Winkler does not specifically suggest that the device is to be tilted, but it is inherently capable of doing so. A skilled artisan would be motivated to tilt the device if, e.g., the most convenient place to set it down was not perfectly flat. Winkler's device is clearly capable of being set down on a tilted surface. In the normal course of use, Winkler's device would be rested on a non-flat surface, and the touch screen of Winkler's device will extend out from the vertically extending boundary of the footprint of the housing." (Official Action, 9/20/10, pp. 3-4). First, the BPAI disagrees with the submitted comments as to what "would have been obvious." Second, the conclusion the examiner reaches is not supported by the example presented. The vertically extending boundaries of the footprint of the device are not independent from the device. If one were to move or tilt the device as suggested, the vertically extending boundaries would move or tilt with the device because the vertically extending boundaries are defined by the footprint of the device. In other words, you can't move the footprint of the device and have the boundaries remain in the last location the device was position, nor are the boundaries limited to a particular orientation

(e.g., a 90 degree angle up relative to the surface of the earth) of the device relative to the surface it sits upon.

As previously stated, Applicant believes that discussion of the combination of references in view of claims 19-31, 46-47 is inappropriate in view of the decision issued by the BPAI. It was the comments that necessitated the above remarks, which Applicant believes created confusion on the record.

Rejections under 35 U.S.C. §103(a)

The Examiner has rejected claims 19-23, 26-31, 46-47 and 49 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0076410 (Beutter) in view of U.S. Patent Application Publication No. 2002/0149706 (Rosen).

Claim 19 has been amended to recite "a housing for enclosing said processor, said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing, said touch screen deflectable about an axis of said housing." Accordingly, claim 19 includes all the previous limitations and has been amended to further include "said touch screen deflectable about an axis of said housing."

The examiner has submitted that "Beutter does not disclose . . . said touch screen movable between a first position at least partially within a footprint of said housing and a second position extended from said footprint of said housing" but that "Rosen discloses . . . that a touch screen ("20") is movable between a first position at least partially within a footprint ("slot 18") of a housing and a second position (see Figures 5-6) extended from said footprint ("free space adjacent to free edge 16") of said housing." (Official Action 9/20/10, p. 5). The examiner then concludes "it would have been obvious . . . to combine the medical video instrument disclosed by Beutter with the retractable monitor disclosed by Rosen. It is obvious to combine prior art elements according

to known methods to yield predictable results. In combination, the medical video instrument and the retractable monitor would have performed the same function as they had separately; a skill artisan would have recognized that the result of the combination was predictable." (*Id.*) Applicant disagrees with the examiner's characterization of Rosen.

Rosen does not disclose "a touch screen ("20")." Nowhere in Rosen is a "touch screen" disclosed or mentioned. Rather, with regard to "display screen 20", Rosen teaches that the "screen may be of any type, but preferably will take the form of a flat panel display screen, such as a liquid crystal display (LCD) screen or a thin film transistor (TFT) display screen." (¶¶ 15, 19). Rosen provides further insight on what "display screen 20" is where it states "a video display configured for storage within an edge of a table or counter, particularly in locations where space is limited. For example, such a video display would be useful in recreational vehicles, campers, buses and boats, where space is at a premium, but where video displays are often used." (¶2). The "display screen 20" was provided to take the place of a "traditional CRT" display, which is provided to display television/video programs to a user. (¶¶ 3, 4). Accordingly, there is absolutely no teaching in Rosen that the "display screen 20" may comprise a touch screen.

Applicant disagrees with the examiner's statement that "the medical video instrument and the retractable monitor would have performed the same function as they had separately." (Official Action 9/20/10, p. 5). Rosen teaches that a "display screen 20" may be positioned in a "frame 26" that may then be affixed to the underneath of a "tabletop, a countertop, a work bench top, a desktop or any article of furniture that incorporates a generally horizontal top with a thickness suitable to house a video display", such as found "in recreational vehicles, campers, buses and boats." (¶¶ 2, 15, 16; FIGS. 1-7). Accordingly, the device in Rosen was to affix a display screen to an interior of a countertop thereby saving the limited countertop space in the vehicle. Alternatively, Beutter is directed toward an endoscope viewing system having a separate "camera

control unit 34" and "monitor 36." (¶¶ 27, 28; FIG. 1). There is absolutely no teaching in Beutler that the "monitor 36" should be or that it would be advantageous to, incorporated into the housing of "camera control unit 34." There is absolutely no teaching in Rosen that it would be advantageous to position the video display in a device housing (such as a camera control unit), in fact, Rosen actually teaches against this teaching that the device should be installed in a countertop.

It is the Examiner's burden to establish prima facie obviousness. See *In re Rijk-aert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, we find that the examiner has not provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention. A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976). In this case, the examiner is not only suggesting Rosen not be installed in a countertop, but that it would be obvious to discard this primary teaching in favor of positioning it in a camera control unit, a modification that is not suggested by either reference. It is incumbent upon the Examiner to establish the factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). It does not matter how strong the Examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103 as neither

circumstance is a substitute for evidence lacking on the record. In this case there is absolutely no evidence presented by the examiner in support of the suggested combination other than an unsupported assertion by the examiner that it "is obvious to combine prior art elements according to known methods to yield predictable results." A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the references. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Additionally, it is well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that not only has the examiner failed to provide "some objective reason to combine" but, in fact, Rosen teaches away from the combination as it is entirely directed toward the positioning of a display screen in a countertop in a vehicle where space is at a premium. The examiner's statement that the "combination . . . would have performed the same function as they had separately", is incorrect as the device in Rosen would not perform the function it was intended to perform, namely, provide space-savings in a surface in, for example, a vehicle.

It is respectfully submitted that claims 19-22, 24-31, 46, 48 and 49, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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